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Amendment After Final
Attorney Docket No. S63.2N-8429-US04

Remarks

This Amendment is in response to the Final Office Action dated **October 31, 2003** wherein claims 34, 35, 37-40 and 42-46 were rejected and/or objected to.

The specific rejections/objections are discussed in greater detail below and are addressed in the same order and with paragraph headings which correspond to the Final Office Action.

Claim Objections

In the Final Office Action claims 38-40 and 46 were objected to because there was said to be no clear teaching in the Application that the diameter of the stent continuously increases from a first diameter at a first end of the stent to a second diameter at a second end of the stent as described in the claims. In the Final Office Action it is asserted that the Application provides support for "a gradual or continual" increase in diameter of the stent along part of the length of the stent. The use of the phrase "continuously" in the instant claims was also discussed with Examiner Prebilic in a telephone interview on December 18, 2003.

In a meeting between Jonathan Grad and Supervisory Examiner McDermott on December 18, 2003, the deletion of the word "continuously" from the claims was discussed in order to overcome the above objection. Because claims 38 and 46 both refer to the diameter of the stent continuously increasing claims 38 and 46 have been cancelled.

In the Final Office Action claims 34, 35, 38 and 42-46 were objected to because the claims state that the stent has a tapered configuration in the expanded state, but in the Examiner's view only "each annular element" can have an expanded state and thus the expanded state of the stent lack antecedent basis.

In Supervisory Examiner McDermott's interview summary of the above referenced meeting, Supervisory Examiner McDermott stated that the antecedent basis rejection is not necessary as the claim is understandable.

Claim Rejections – 35 USC §102

In the Final Office Action claims 34, 35 and 37-40 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. 5,064,435 to Porter. More specifically, the Final Office

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Action asserts that the flared end of the device shown in FIG. 1 of Porter would inherently have a higher flexibility because of its same braid angle but larger diameter.

Porter is silent as to any difference in flexibility. The Office Action, in asserting inherency, asserts that "The flared end would inherently have a higher flexibility because of its same braid angle but larger diameter." It is inappropriate, however, to conclude from the figures that the braid angle of the different regions is the same, in particular, given that the stent of Porter is woven. Therefore, the inherency argument also does not follow, given that it was premised on regions of different diameter having the same braid angle. To that end, Applicant notes that in the interview summary provided by Supervisory Examiner McDermott, as discussed above, Supervisory Examiner McDermott stated that in regard to Porter it is "not clear how it is inherently more flexible because of the larger diameter."

Applicant also notes that the claims recite that the stent is cut from a tube. This feature is also not taught or suggested by Porter. Porter is constructed from woven wires.

In light of the failure of Porter to teach all of the elements of the instant claims the rejection is respectfully traversed.

In the Final Office Action claims 34, 35 and 37-40 were rejected under §102(e) as being anticipated by U.S. 5,922,019 to Hankh et al (Hankh). As indicated above independent claims 34 and 39 have been amended to clarify that the stent respectively claimed is cut from a tube. This is in contrast to Hankh which clearly describes a stent which comprises a self-expandable braided tubular wall (abstract, lines 1-4). One of ordinary skill will recognize that a stent which is braided or formed from a braid of material is structurally different than a stent cut from a tube as in the instant claims. Because Hankh fails to teach all of the elements of the instant claims the rejection is respectfully overcome.

Claim Rejections – 35 USC §103

In the Final Office Action claims 34, 35, 37 and 42-45 were rejected under §103(a) as being obvious over U.S. 6,348,065 to Brown et al (Brown) in view of U.S. 5,575,818 to Pinchuk. More specifically the Final Office Action asserts that Brown discloses a stent made of a single piece of material having a tapered configuration and that Pinchuk discloses that it was known to make stents with ends having different degrees of flexibility and that it would be

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obvious to make the ends of the Brown stent with different flexibilities for the same reasons that Pinchuk does.

In response, Applicant asserts that there is nothing in either of the cited references which teaches or suggests a stent that has a tapered configuration with ends having different degrees of flexibility as claimed. More specifically, Applicant asserts that neither of the references cited in the Office Action teach or suggest a stent having a tapered configuration as would be understood by one of ordinary skill based on the plain meaning of the claim language and/or the scope of the Application as a whole.

Given that Brown does not show or describe a stent having a tapered configuration in a telephone interview between Jonathan Grad and Examiner Prebilib on December 18, 2003 Mr. Grad questioned how Brown could be interpreted as having a tapered configuration. In response the Examiner explained that the taper which he considers to be present in the Brown stent is shown in FIG. 4 between the bend (19a) and the strut (18) (FIG. 4 of Brown appears to show some of the bends (19a) as having a thinner width than that of the adjacent struts (18), though such a thinning is not consistent in the drawing nor is it discussed anywhere in the specification.

Though Mr. Grad insisted that this is not the way the language was understood in the Roubin patent (U.S. 6,106,548), from which the instant claims as originally filed were copied, the Examiner nevertheless felt that he is not bound by the apparent understanding of the claim language in Roubin and that there is a reasonable basis for reading the claims in the current manner which he has chosen. Applicant respectfully disagrees.

Applicant respectfully asserts that it is *not* reasonable to interpret the stent of Brown as having a tapered configuration as stated in the instant claims merely because some of the bends (19a) appear to be thinner than the adjacent struts (18). One of ordinary skill will understand that the claims as stated are directed to providing a portion of the stent with an increasing diameter or decreasing diameter (depending on the point of view) along a length of the stent i.e. a tapered configuration. The specification clearly and most descriptively discusses the term "taper" in this well recognized and understood manner (page 15, line 4 to page 16, line 11) and the Examiner has no "reasonable basis" for ignoring such a plain meaning description in interpreting the meaning of the claim language.

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Because neither of the cited references teach or suggest a stent having a tapered configuration in the manner described in the instant claims the rejection is respectfully overcome.

Allowable Subject Matter

In the Final Office Action claim 46 was objected to as being dependent on a rejected base claim but would be allowable if rewritten in independent form.

As indicated above claim 46 has been cancelled. Claim 46 was differentiated from claim 45 in its inclusion of the word "continuously". Per the interview with Primary Examiner McDermott, the word "continuously" has been cancelled in order to overcome the objection to the claim. Since claim 46 without the term "continuously" would then be identical to claim 45, claim 46 has been cancelled.

CONCLUSION

In view of the foregoing it is believed that the present application, with claims 34, 35, 37, 39, 40, 42-45 and 47 is in condition for allowance or appeal.

Respectfully submitted,

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